

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-10, 12 and 13 are rejected under 35 U.S.C. 102(b) over the patent to Kabayashi, et al.

Claim 11 is rejected under 35 U.S.C. 103(a) over the patent to Kabayashi in view of the patent to Ellings.

At the same time, the claims are objected to.

In connection with the Examiner's objection to the claims, applicants have amended claims 5 and 11 as suggested by the Examiner.

The Examiners suggestions are gratefully appreciated.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants retained claims 1, 11 and 12, the broadest independent claims on file, as they were.

It is respectfully submitted that the new features of the present invention which are defined in the claims clearly and patentably distinguish the present invention from the applied prior art.

Before the analysis of the prior art it is believed to be advisable to explain to the Examiner the new features of the present invention.

In accordance with the present invention a method of quantitative determination of an image drift in a digital imaging microscope is proposed.

In accordance with the inventive method a pattern is used which has a plurality of features spaced from one another into mutually perpendicular directions, then a set of images of the pattern (the same pattern) is produced in the certain time intervals therebetween and an offset of each of the features in the set of the thusly obtained images is determined as an image drift, wherein the pattern can include four features and offsets of the centers of each features is determined, also an offset of a center of the centers of all features can be determined, also a turning of the centers of the features can be determined.

It is emphasized that the method deals with the same pattern (the pattern), and sets of images are compared which are images of the same pattern with certain time intervals with it.

When the method is performed in accordance with the present invention, it is possible to determine for a user which uses a digital imaging microscope how stable the image is in order to perform precise measurements of features. Image drift or movement relative to time affects measurement accuracy because the image will be distorted if there is a drift.

The patent to Koitabashi discloses a completely different method. In the patent to Koitabashi a displacement of images on two different sets of objects is determined, such as for example on two different photomasks. This displacement is important in IC lithography where different sets of images must overlay on each other, and each set of images is used to build different layers in the IC device. The method disclosed in the patent to Koitabashi is used for steppers and scanners. The sets of different objects which are analyzed in the method to Koitabashi are patterns in masks. Thus, Koitabashi does not determine an offset of features in a set of images of the pattern (the same pattern) obtained by the digital imaging microscope, with time intervals therebetween, and therefore Koitabashi can

not quantitatively determine an image drift in a digital imaging microscope, in order to perform precise measurements.

The Examiner rejected the claims in the present application under 35 U.S.C. 102(b) over the patent to Koitabashi. In connection with this, it is believed to be advisable to cite the decision in *re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Koitabashi does not disclose each and every element of the method in accordance with the present invention.

This reference as well as the secondary reference do not provide any hint or suggestion that such features can be disclosed in them. Therefore an obviousness rejection is also not applicable, since in order to arrive at the applicant's invention from the teachings of the references, the references have to be fundamentally modified by including into them the features which were first proposed by the applicant. However, it is known

that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Finally, the present invention provides for the highly advantageous results which we explained herein above, and can not be accomplished by the method disclosed in the references.

It is also well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushima and Takahashi (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no

suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

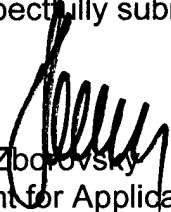
In view of the above presented remarks and amendments, it is believed that claims 1, 11 and 12 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-243-3818).

Respectfully submitted,



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